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| 10/633,563      | 08/05/2003  | Masashi Eguchi       | 030849              | 7130             |

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| EXAMINER |
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LIN, WEN TAI

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| ART UNIT | PAPER NUMBER |
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2154

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08/29/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/633,563

Applicant(s)

EGUCHI ET AL.

Examiner

Wen-Tai Lin

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 8/5/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4/06, 1/06, 8/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1. Claims 1-24 are presented for examination.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 10, 14-18, 21 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Mori et al.[U.S. PGPub 20010013056].
4. As to claim 1, Mori teaches the invention as claimed including: an electronic mail server device [e.g., Figs. 2 and 7] comprising:  
means for receiving an electronic mail [e.g., S701-S702, Fig.7];

means for determining whether a prescribed processing condition is satisfied in accordance with the received electronic mail [e.g., S703, Fig.7]; and

means for controlling to execute a prescribed processing to the received electronic mail when the processing condition is satisfied [e.g., S704-S711, Fig. 7].

5. As to claim 2, Mori further teaches that the prescribed processing condition is when a size of the received electronic mail or an attached file exceeds a prescribed value, and when the size of the received electronic mail or the attached file exceeds the prescribed value [Abstract], the means for controlling executes the following processing:  
(a) dividing and forwarding the electronic mail [e.g., Fig.7];

6. As to claim 3, Mori further teaches that the prescribed value of the size of the electronic mail or the attached file is a value specific to each electronic mail address or each domain of a destination of the electronic mail [e.g., S702, Fig.7; i.e., the upper limit value is specific to the destination address].

7. As to claim 10, Mori further teaches that the prescribed processing condition is when specific data is included in the received electronic mail [i.e., the mail dividing information], and when the specific data is included in the received electronic mail, the means for controlling executes the following processing:

(a) removing the specific data from the electronic mail and forwarding the electronic mail [e.g., paragraphs 88 -112; Figs. 9-10; i.e., the mail dividing information is removed after the divided mail pieces are put together as its original mail];

8. As to claim 14, Mori further teaches that the prescribed processing condition is when receiving a plurality of divided electronic mails, and when receiving the plurality of divided electronic mails, the means for controlling restores the received plurality of divided electronic mails into one electronic mail, and forward the electronic mail [Figs. 8-10].

9. As to claim 15, Mori further teaches that the means for controlling receives data which defines the processing condition and processing corresponding to the processing condition from a remote device under a prescribed communication protocol [e.g., paragraph 10; i.e., the content of preference information is entered by remote subscribers].

10. As to claims 16-18, 21 and 24, since the features of these claims can also be found in claims 1-2, 10 and 14, they are rejected for the same reasons set forth in the rejection of claims 1-2, 10 and 14 above.

11. Claims 1, 4-9 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Balma et al.[U.S. Pat. No. 6157945].

12. As to claims 1, 4 and 6, Balma teaches the invention as claimed including: an electronic mail server device comprising:

means for receiving an electronic mail [e.g., Fig.1; Abstract];

means for determining whether a prescribed processing condition is satisfied in accordance with the received electronic mail [e.g., Figs. 13-14]; and

means for controlling to execute a prescribed processing to the received electronic mail when the processing condition is satisfied [e.g., Fig. 17].

13. Balma further teaches that the prescribed processing condition is when an attached file of the received electronic mail is a specific format, and when the attached file of the received electronic mail is the specific format [e.g., col.1, lines 9-13; Fig. 5], the means for controlling executes the following processing:

(a) converting the attached file into a prescribed format and forwarding [e.g., col. 8, lines 16-33; col.4, lines 51-61; col.5, lines 65-67; col. 8, line 61- col. 9, line 10];

14. As to claims 5 and 7, Balma further teaches that the specific format is a format which is specific to each electronic mail address or each domain of a destination of the electronic mail [i.e., the target format is selected by each recipient using database fields of Fig.5].

15. As to claims 8-9 and 19-20, since the features of these claims can also be found in claims 4 and 6-7, they are rejected for the same reasons set forth in the rejection of claims 4 and 6-7 above.

16. Claims 1, 11-12 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Katsikas [U.S. PGPub 20050188045].

17. As to claims 1, 11, Katsikas teaches the invention as claimed including: an electronic mail server device comprising:

means for receiving an electronic mail

means for determining whether a prescribed processing condition is satisfied in accordance with the received electronic mail; and means for controlling to execute a prescribed processing to the received electronic mail when the processing condition is satisfied [e.g., Fig. 1B and 4B].

Katsikas further teaches that the prescribed processing condition is when a transmitter terminal of the received electronic mail is a specific address or a specific domain, and when the transmitter terminal of the received electronic mail is the specific address or the specific domain, the means for controlling executes the following processing: (a) forwarding the electronic mail to a prescribed destination [e.g., 211, Fig.4B];

18. As to claim 12, Katsikas further teaches that the prescribed processing condition is when a transmitter terminal of the received electronic mail is neither a specific address nor a specific domain, and when the transmitter terminal of the received electronic mail is neither the specific address nor the specific domain, the means for controlling executes the following processing:

(a) forwarding the electronic mail to a prescribed destination [e.g., paragraphs 25 and 34-35];

19. As to claim 22, since the features of this claim can also be found in claims 11, it is rejected for the same reasons set forth in the rejection of claims 11 above.

***Claim Rejections - 35 USC § 103***

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 13 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al.(hereafter "Mori")[U.S. PGPub 20010013056], as applied to claims 1-3, 10, 14-18, 21 and 24 above, further in view of Official Notice.



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22. As to claims 13 and 23, Mori does not specifically teach what to do when failing to forward the received electronic mail.

However, Official Notice is taken that it is well known fail-to-delivered emails are normally returned to their respective senders.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to return a fail-to-delivered email back to its sender because it alerts the sender of the failure such that new delivery method may be attempted.

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Bates et al. [U.S. Pat. No. 6810408];

Hall et al. [U.S. PGPub 20040010554]; and

Kucherawy [U.S. PGPub 20030028580].

### ***Conclusion***

**Examiner note:** Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part

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of the claimed invention, as well as the contest of the passage as taught by the prior art or disclosed by the Examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (571)272-3969. The examiner can normally be reached on Monday-Friday(8:00-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Flynn can be reached on (571) 272-1915. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

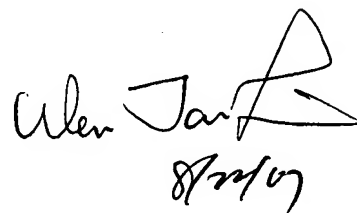
(571) 273-8300 for official communications; and

(571) 273-3969 for status inquires draft communication.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Wen-Tai Lin

August 22, 2007



Wen-Tai Lin  
8/22/07